



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,483	01/15/2004	Michael James Denney	ROC920030373US1	6196
30206	7590	03/05/2008	EXAMINER	
IBM CORPORATION			JOO, JOSHUA	
ROCHESTER IP LAW DEPT. 917				
3605 HIGHWAY 52 NORTH			ART UNIT	
ROCHESTER, MN 55901-7829			PAPER NUMBER	
			2154	
			MAIL DATE	
			DELIVERY MODE	
			03/05/2008	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/758,483

Applicant(s)

DENNEY ET AL.

Examiner

JOSHUA JOO

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

1. This Office action is in response to communication dated 11/26/2007.

Claims 1-20 are presented for examination.

**Response to Arguments**

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant is seeking to patent an apparatus comprising of means for functions, wherein Applicant's specification states that the embodiments may be implemented in manners including computer software application, routines, components, programs object, modules, data structures etc..., referred hereinafter as "computer programs," or simply "programs." (Specification, page 10, lines 1-5). One of skilled in the art may reasonably interpret the "means for" as program means based on the specification, and as such, the claimed apparatus is directed to only programs, i.e. software. Programs do not meet one of the four categories of invention and is not statutory. Specifically, programs are not series of steps or acts and thus are not processes. Programs are not a physical article or object and as such are not machines or manufactures. Programs are not combinations of substances and therefore are not composition of matter.

Art Unit: 2154

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) Regarding claim 1, "the e-mail address" lacks sufficient antecedent basis as the claim comprises more than one "an e-mail address".
- ii) Regarding claim 6, the claim is indefinite because the apparatus does not comprise any functional hardware but of "means for", in which "means for" may be interpreted as software means based on the Applicant's specification. Applicant's specification states that the embodiments may be implemented in manners including computer software application, routines, components, programs object, modules, etc... (specification, page 10, lines 1-5). The scope of the claim is not clear.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 6-7, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh, US Publication #2002/0107930 (Itoh hereinafter), in view of Schoeffler, US Publication #2001/0049745 (Schoeffler hereinafter).

9. As per claim 1, Itoh teaches substantially the invention as claimed including a method comprising:

Art Unit: 2154

removing a recipient identifier from an e-mail if a recipient identifier in the e-mail does not comprise an e-mail address (Paragraphs 0080; 0088. Subtract destination from email message. Figs 10b-f, h; Paragraph 0101. Personal name is displayed on email message.);

retaining the recipient identifier in the e-mail if the recipient identifier comprises an e-mail address (Paragraph 0104. Email message displays mail address.);

sending the e-mail, if the e-mail comprises the e-mail address (Paragraph 0128. Transmit outgoing email message.); and

sending the e-mail, if any other recipient identifier remains in the e-mail after the removing (Paragraphs 0080; 0088. Destination(s) may be removed from email message. Paragraph 0128. Transmit outgoing email message. It is inherent destination(s) may be removed and message sent with remaining destinations.).

10. Itoh teaches of removing a recipient identifier from an email if a recipient identifier in the e-mail does not comprise an e-mail address but does not specifically teach of printing the e-mail, and printing a street address associated with the recipient identifier on an envelope.

11. Schoeffler teaches of transmitting electronic mails in a plurality of transmission methods, wherein an electronic mail may be sent to a postal address after printing (Paragraphs 0047; 0060).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to print the email to send to the recipient's postal address. The motivation for the suggested combination is that Schoeffler's teachings would enhance Itoh's system by providing a sender with a plurality of different methods to communicate messages to recipient(s). Schoeffler teaches printing the electronic mail and the envelope comprising the street address but does not explicitly teach of "printing" the street address on the envelope. It would have been obvious to one of ordinary skill in the art to also print the postal address on the envelope, which would provide an efficient method of preparing and sending postal mail.

13. As per claims 6 and 11, Itoh teaches substantially the invention as claimed including an apparatus and storage medium comprising:

means for removing a recipient identifier from an e-mail if a recipient identifier in the e-mail does not comprise an e-mail address (Paragraphs 0080; 0088. Subtract destination from email message. Figs 10b-f; h; Paragraph 0101. Personal name is displayed on email message.);

means for retaining the recipient identifier in the e-mail if the recipient identifier comprises the e-mail address (Paragraph 0104. Email message displays mail address.);

means for sending the e-mail, if the e-mail comprises the e-mail address (Paragraph 0128. Transmit outgoing email message.); and

means for sending the e-mail, if any other recipient identifier remains in the e-mail after the removing (Paragraphs 0080; 0088. Destination(s) may be removed from email message. Paragraph 0128. Transmit outgoing email message. . It is inherent destination(s) may be removed and message sent with remaining destinations.).

14. Itoh teaches of removing a recipient identifier from an email if a recipient identifier in the e-mail does not comprise an e-mail address but does not specifically teach of printing the e-mail, and printing a street address associated with the recipient identifier on an envelope.

15. Schoeffler teaches of transmitting electronic mails in a plurality of transmission methods, wherein an electronic mail may be sent to a postal address after printing (Paragraphs 0047; 0060).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to print the email to send to the recipient's postal address. The motivation for the suggested combination is that Schoeffler's teachings would enhance Itoh's system by providing a sender with a plurality of different methods to communicate messages to recipient(s). Schoeffler teaches of the envelope comprising the street address but does not explicitly teach of "printing" the street address

Art Unit: 2154

on the envelope. It would have been obvious to one of ordinary skill in the art to print the postal address on the envelope, which would provide an efficient method of sending postal mail.

17. As per claims 2, 7, and 12, Itoh and Schoeffler taught the method, apparatus, and storage medium. Itoh does not specifically the method, apparatus, and storage medium of claims 1, 6, and 11, further comprising: obtaining the street address from an address book, wherein an entry in the address book is associated with the recipient identifier.

18. Schoeffler teaches of obtaining the street address from an address book, wherein an entry in the address book is associated with the recipient identifier (Table between paragraph 0056-0057. Postal address associated with old address.).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings obtain the street address from an address book, wherein an entry in the address book is associated with the recipient identifier. The motivation for the suggested combination is that Schoeffler's teachings would allow identification and retrieval of a recipient's postal address for sending of communication.

20. Claims 3, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh and Schoeffler, in view of Harris, US Publication #2003/0229632 (Harris hereinafter).

21. As per claims 3, 8, and 13, Itoh does not specifically teach the method, apparatus, and storage medium of claims 1, 6, and 11, wherein the recipient identifier comprises the street address.

22. Harris teaches of a recipient identifier comprising a street address (Paragraph 0073-0073).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the recipient identifier to comprise a street address. The motivation for the

Art Unit: 2154

suggested combination is that Harris' teachings would provide recipient's postal information to send the electronic mail as postal mail.

24. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh and Schoeffler, in view of Brookner et al. US Patent #6,897,973 (Brookner hereinafter).

25. As per claims 4, 9, and 14, Itoh does not specifically teach the method, apparatus, and storage medium of claims 1, 6, and 11, further comprising: printing postage on the envelope.

26. Brookner teaches of printing postage on an envelope (abstract).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to print postage on the envelope. The motivation for the suggested combination is that Brookner's teachings would improve efficiency in preparing and sending postal mail.

28. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh and Schoeffler, in view of Maxwell, US Patent #5,805,810 (Maxwell hereinafter).

29. As per claims 5 and 10, Itoh does not specifically teach the method and apparatus of claims 2 and 7, further comprising: determining whether to perform the removing, the printing the e-mail and the printing street addressed based on an option associated with the address book.

30. Maxwell teaches a system for converting electronic mail to postal mail, wherein the system determines whether to perform the removing, the printing the e-mail and the printing street addressed based on an option associated with the address book (col. 8, line 18-29. Determine whether to process the email message. col. 8, lines 40-46; col. 12, line 55-60. Process involves extracting identifier, printing the email and street address. col. 9, lines 59-62. Recipient database. The option to process the email message is associated with the recipient database.).



Art Unit: 2154

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to determine whether to perform the removing, the printing the e-mail and the printing street addressed based on an option associated with the address book. The motivation for the suggested combination is that Maxwell's teachings would allow validation of the email message to determine a method for communicating the electronic mail to the recipient.

32. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh, Schoeffler, and Brookner, in view of Maxwell, US Patent #5,805,810 (Maxwell hereinafter).

33. As per claim 15, Itoh does not specifically teach the storage medium of claim 14, wherein the instructions further comprise: subtracting a cost of the postage from an account associated with an originator of the e-mail.

34. Maxwell teaches a system for converting electronic mail to postal mail, wherein the system subtracts a cost of the postage from an account associated with an originator of the e-mail (col. 13, lines 28-31).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to subtract a cost of the postage from an account associated with an originator of the e-mail. The motivation for the suggested combination is that Maxwell's teachings would provide an efficient method to allow the sender to provide payment of postal mail, and obtain credit for postage.

36. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh, in view of Schoeffler and Maxwell.

37. As per claim 16, Itoh teaches substantially the invention as claimed, including a computer system comprising:

Art Unit: 2154

a processor; and memory encoded with instructions, where the instructions when executed on the processor comprise (Paragraph 0057. Processors such as personal computers.):

removing a recipient identifier from an e-mail if a recipient identifier in the e-mail does not comprise an e-mail address (Paragraphs 0080; 0088. Subtract destination from email message. Figs 10b-f, h; Paragraph 0101. Personal name is displayed on email message.),

retaining the recipient identifier in the e-mail if the recipient identifier comprises an e-mail address (Paragraph 0104. Email comprises and displays email address.);

sending the e-mail, if the e-mail comprises an e-mail address (Paragraph 0128. Transmit outgoing email message.),

sending the e-mail, if any other recipient identifier remains in the e-mail after the removing (Paragraphs 0080; 0088. Destination(s) may be removed from email message. Paragraph 0128. Transmit outgoing email message. . It is inherent destination(s) may be removed and message sent with remaining destinations.), and

38. Itoh does not specifically teach of printing the e-mail, and printing a street address associated with the recipient identifier on an envelope; and determining whether to perform the removing, the printing the e-mail, and the printing the street addressed based on an option associated with an address book.

39. Schoeffler teaches of transmitting electronic mails in a plurality of transmission methods, wherein an electronic mail may be sent to a postal address after printing (Paragraphs 0047; 0060).

40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to print the email to send to the recipient's postal address. The motivation for the suggested combination is that Schoeffler's teachings would enhance Itoh's system by providing a sender with a plurality of different methods to communicate messages to recipient(s). Schoeffler teaches of the envelope comprising the street address but does not explicitly teach of "printing" the street address

Art Unit: 2154

on the envelope. It would have been obvious to one of ordinary skill in the art to print the postal address on the envelope, which would provide an efficient method of sending postal mail.

41. Maxwell teaches a system for converting electronic mail to postal mail, wherein the system determines whether to perform the removing, the printing the e-mail and the printing street addressed based on an option associated with the address book (col. 8, line 18-29. Determine whether to process the email message. col. 8, lines 40-46; col. 12, line 55-60. Process involves extracting identifier, printing the email and street address. col. 9, lines 59-62. Recipient database. The option to process the email message is associated with the recipient database.).

42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to determine whether to perform the removing, the printing the e-mail and the printing street addressed based on an option associated with the address book. The motivation for the suggested combination is that Maxwell's teachings would allow validation of the email message to determine a method for communicating the electronic mail to the recipient.

43. As per claim 17, Itoh does not specifically teach the system of claim 16, further comprising: obtaining the street address from an address book, wherein an entry in the address book is associated with the recipient identifier.

44. Schoeffler teaches of obtaining the street address from an address book, wherein an entry in the address book is associated with the recipient identifier (Table between paragraph 0056-0057. Postal address associated with old address.).

45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings obtain the street address from an address book, wherein an entry in the address book is associated with the recipient identifier. The motivation for the suggested combination is that

Art Unit: 2154

Schoeffler's teachings would allow identification and retrieval of a recipient's postal address for sending of communication.

46. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh, Schoeffler, and Maxwell, in view of Harris.

47. As per claim 18, Itoh does not specifically teach the system of claim 16, wherein the recipient identifier comprises the street address.

48. Harris teaches of a recipient identifier comprising a street address (Paragraph 0073-0073).

49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the recipient identifier to comprise a street address. The motivation for the suggested combination is that Harris' teachings would provide recipient's postal information to send the electronic mail as postal mail.

50. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh, Schoeffler, and Maxwell, in view of Brookner.

51. As per claim 19, Itoh does not specifically teach the system of claim 16, further comprising: printing postage on the envelope.

52. Brookner teaches of printing postage on an envelope (abstract).

53. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to print postage on the envelope. The motivation for the suggested combination is that Brookner's teachings would improve efficiency in preparing and sending postal mail.

Art Unit: 2154

54. As per claim 20, Itoh does not specifically teach the computer system of claim 19, wherein the instructions further comprise: subtracting a cost of the postage from an account associated with an originator of the e-mail.

55. Maxwell teaches a system for converting electronic mail to postal mail, wherein the system subtracts a cost of the postage from an account associated with an originator of the e-mail (col. 13, lines 28-31).

56. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to subtract a cost of the postage from an account associated with an originator of the e-mail. The motivation for the suggested combination is that Maxwell's teachings would provide an efficient method to allow the sender to provide payment of postal mail, and obtain credit for postage.

### **Conclusion**

57. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

58. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

59. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

60. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained

Art Unit: 2154

from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./

Examiner, Art Unit 2154

  
NATHAN FLYNN  
SUPERVISORY PATENT EXAMINER